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EXAMINER

SINGH, SATWANT K

ART UNIT PAPER NUMBER

2626

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/898,276	<b>Applicant(s)</b> HIRAOKA, TORU	
	<b>Examiner</b> Satwant K. Singh	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 18 is objected to because of the following informalities: the “,” at the end of the sentence should be a “.”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 10-12, 14, 18, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigemura (US 5,604,598).
3. Regarding Claim 1, Shigemura discloses an image processing apparatus (facsimile apparatus 101) comprising:
  - a) a color image inputting unit for inputting a color image (image scanner 26);
  - b) a printer unit for printing a monochrome image (white/black printer 28);
  - c) an interface to which an external color printer can be connected (printer interface 32); and
  - d) a control unit (main control circuit 10) for determining whether a color image inputted from the color image inputting unit is printed on the printer unit as a

monochrome image, or printed on the external color printer as a color image (Fig. 6A S22, 26 and 30) (col. 3, lines 66-67, col. 4, lines 1-4).

4. Regarding Claim 2, Shigemuara discloses an apparatus, wherein the color image inputting unit includes a color image scanner unit for scanning a color image (image scanner 26) (col. 3, lines 20-21).

5. Regarding Claim 3, Shigemura discloses an apparatus, wherein the color image inputting unit includes a LAN interface (network 105) (Fig. 3).

6. Regarding Claim 10, Shigemura discloses an apparatus, wherein the control unit judges whether an image inputted by the color image inputting unit is black-and-white or color, and when the control unit judges the image is black-and-white, the control unit causes the image to be printed on the printer unit (if the color image is not contained, the image data to be printed is supplied to the monochrome printer 28 (S30)), and when the control unit judges the image is color, the control unit causes the image to be printed on a color printer via the interface (if a small bit of color image is contained in one document, the image data of one document to be printed is supplied to the color printer 34 through the printer interface 32 (S26))(col. 3, lines 66-67. col. 4, lines 1-4).

7. Regarding Claim 11, Shigemura discloses an apparatus, further including a message output unit (printout) for making notification to a user, wherein the control unit communicates to a user via the message output unit a message that printing on a color printer is completed (messages shown in FIGS. 7 to 9 are visually outputted and therefore the user can discriminate which printer has been used to print out the document and operation efficiency is improved) (col. 5, lines 15-17).

8. Regarding Claim 12, Shigemura discloses an apparatus, wherein a plurality of color printers are connected to the apparatus (Fig. 3, color printers 34 and 134), and the message includes information as to which color printer has performed the printing (messages shown in FIGS. 7 to 9 are visually outputted and therefore the user can discriminate which printer has been used to print out the document and operation efficiency is improved) (col. 5, lines 15-17).

9. Regarding Claim 14, Shigemura discloses an apparatus, wherein the control unit causes the message to be printed on the printer unit ((messages shown in FIGS. 7 to 9 are visually outputted and therefore the user can discriminate which printer has been used to print out the document and operation efficiency is improved) (col. 5, lines 15-17).

10. Regarding Claim 18, Shigemura discloses an apparatus, wherein the interface includes a LAN interface (network 105) (Fig. 3), and the message is transmitted to a user through the LAN interface (messages shown in FIGS. 7 to 9 are visually outputted and therefore the user can discriminate which printer has been used to print out the document and operation efficiency is improved) (col. 5, lines 15-17).

11. Claims 19 and 20 are rejected for the same reason as claim 1.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4, 9, 13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigemura in view of Wakai et al. (US 6,697,165).

14. Regarding Claim 4, Shigemura fails to teach an image processing apparatus, wherein the color image inputting unit includes a network control unit and a modem.

Wakai et al teach an image processing apparatus, wherein the color image inputting unit includes a network control unit and a modem (controller 605 can control a remote device across a network via the device that is near the controller 605) (col. 9, lines 43-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Wakai to allow remote access from the color image inputting unit.

15. Regarding Claim 9, Shigemura fails to teach an apparatus, further including an operation unit for allowing a user to select whether an inputted image is printed in black and white, or printed in color, wherein, based on input from the operation unit, the control unit determines whether the image is printed on the printer unit, or printed on the external color printer.

Wakai et al teach an apparatus, further including an operation unit for allowing a user to select whether an inputted image is printed in black and white, or printed in color, wherein, based on input from the operation unit, the control unit determines whether the image is printed on the printer unit, or printed on the external color printer (Fig. 5, User's Request).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teachings of Wakai to give the user a choice as to whether they want the image printed in color or black and white.

16. Regarding Claim 13, Shigemura fails to teach an apparatus, further including a display unit for displaying the message.

Wakai et al teach an apparatus, further including a display unit for displaying the message (Fig. 5, User/Service Center Notified By) (when there is an instruction for notification, an optimal medium is selected to dispatch a notification that the printing has been terminated along with the name of the printer that has performed the printing) (col. 8, lines 56-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Wakai to display the printing results of the image.

17. Regarding Claim 15, Shigemura fails to teach an apparatus, further including a network control unit capable of connecting the apparatus to a public switched telephone network, wherein the message is transmitted to a user through the public switched telephone network.

Wakai et al teach an apparatus, further including a network control unit capable of connecting the apparatus to a public switched telephone network, wherein the message is transmitted to a user through the public switched telephone network (Fig. 5, User/Service Center Notified By) (when there is an instruction for notification, an optimal

medium is selected to dispatch a notification that the printing has been terminated along with the name of the printer that has performed the printing) (col. 8, lines 56-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Wakai to let the user know printing results of the image via a network connection.

18. Regarding Claim 16, Shigemura fails to teach an apparatus, wherein the message is a voice message.

Wakai et al teach an apparatus, wherein the message is a voice message (Fig. 5, User/Service Center Notified By) (when there is an instruction for notification, an optimal medium is selected to dispatch a notification that the printing has been terminated along with the name of the printer that has performed the printing) (col. 8, lines 56-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Wakai to let the user know printing results of the image via a voice message.

19. Regarding Claim 17, Shigemura fails to teach an apparatus, further including a modem which is connected to the network control unit, wherein the message is transmitted to a user by facsimile.

Wakai et al teach an apparatus, further including a modem which is connected to the network control unit, wherein the message is transmitted to a user by facsimile (Fig. 5, User/Service Center Notified By) (when there is an instruction for notification, an optimal medium is selected to dispatch a notification that the printing has been



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terminated along with the name of the printer that has performed the printing) (col. 8, lines 56-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Wakai to let the user know printing results of the image via a fax transmittal.

20. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigemura in view of Waguri (US 6,370,278).

21. Regarding Claim 5, Shigemura fails to teach an image processing apparatus, further including an image conversion unit for converting an inputted color image to a monochrome image.

Waguri teaches an image processing apparatus, further including an image conversion unit for converting an inputted color image to a monochrome image (image processor 12 performs the image conversion from color to black and white) (col. 3, lines 6-7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Waguri to allow for a color image to be converted into black and white.

22. Regarding Claim 6, Shigemura fails to teach an apparatus, further including an operation unit for enabling the setting of parameters to the image conversion unit when a color image is converted to a monochrome image.

Waguri teaches an apparatus, further including an operation unit for enabling the setting of parameters to the image conversion unit when a color image is converted to a

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monochrome image (image processor 12 performs the conversion of the digital signals) (col. 3, lines 42-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Waguri to allow for a color image to be converted into black and white.

23. Regarding Claim 7, Shigemura fails to teach an apparatus, wherein the color image inputting unit includes the image conversion unit.

Waguri teaches an apparatus, wherein the color image inputting unit (scanning device 10) includes the image conversion unit (image processor 12) (Fig. 1) (col. 2, lines 66-67, col. 3, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Waguri to allow for a color image to be converted into black and white.

24. Regarding Claim 8, Shigemura fails to teach an apparatus, wherein the printer unit includes the image conversion unit.

Waguri teaches an apparatus, wherein the printer unit includes the image conversion unit (invention can also be applied to a digital-monochrome copying machine have a color image scanner therein) (col. 5, lines 58-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shigemura with the teaching of Waguri to allow for a color image to be converted into black and white.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamada (S 6,339,654) discloses an image processing method for processing color and monochrome images.

Yorkey et al. (US 6,317,218) discloses printer that monochrome and color printing heads for printing color and monochrome images.

Kono et al (US 6,6529,289) discloses an image processing apparatus with an output device connected thereto.

Shimada et al (US 6,512,899) discloses an image forming apparatus capable of processing images of plural documents.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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